IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicants:	Jean-Luc Pous et al.	§	Art Unit:	3625
		§		
Serial No.:	10/043,856	§		
		§	Examiner:	Nicholas D. Rosen
Filed:	January 11, 2002	§		
		§		
Title:	Custom Engineered	§	Docket No.	22.1489
	Product System And	§		(SHL.0293US)
	Process	§		

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APPEAL BRIEF

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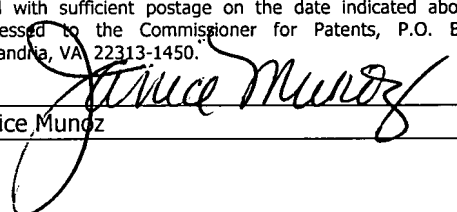
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REAL PARTY IN INTEREST

The real party in interest is Schlumberger Technology Corporation, the assignee of the present application.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

The application was originally filed with claims 1-41. Claims 42-62 were subsequently added and claims 1-37 and 39-41 were subsequently cancelled during the prosecution of the application. In an amendment filed by Applicant on February 6, 2007, Applicant requested the cancellation of claim 28. Although this amendment narrowed down the issues for appeal, the Examiner refused entry of the amendment in an Advisory Action dated February 27, 2007. Therefore, claim 38 remains in the application. Claims 38 and 42-62 have been finally rejected in a Final Office Action dated December 6, 2006. In a Notice of Appeal filed on April 2, 2007, Applicant identified the decision from which this appeal is taken but did not identify the specific claims that are being appealed, which is permitted by the rules. M.P.E.P. § 1204.I. Applicant now identifies that the rejected claims being appealed are claims 42-62.

STATUS OF AMENDMENTS

There are no unentered amendments.

SUMMARY OF CLAIMED SUBJECT MATTER

At this point, no issue has been raised that would suggest that the words in the claims have any meaning other than their ordinary meanings. Nothing in this section should be taken as an indication that any claim term has a meaning other than its ordinary meaning.

The method of independent claim 42 recites providing an online catalog on a computer, with the catalog having an unavailable product/attribute selector to select an unavailable product or attribute that is not offered for sale. In a particular embodiment of the invention, the specification describes an online catalog 30, which offers standard, or available, products 32 and unavailable products/attributes 34. The specification describes that an unavailable product/attribute 34 is one that the seller does not currently offer and that requires engineering, testing or both before it may be produced/sold. Specification, ll. 23-24, p. 5 and ll. 1-4, p. 6. The method of claim 42 also includes using selections of unavailable products or attributes that are not offered for sale obtained via the unavailable product/attribute selector as market research to determine whether to extend a product offering that includes the unavailable products or attributes. In a particular embodiment of the invention, the specification describes that by offering an unavailable size on the online catalog 30, the seller is able to extend their line offering based upon actual market demand as opposed to simply building a new size in the hopes that someone will buy it. Specification, ll. 3-5, p. 7.

The system of independent claim 56 includes a user interface selection device in communication with a processor. The user interface selection device is adapted to display a list of products or attributes that are not currently offered in a line of available products or attributes from a provider. In a particular embodiment of the invention, the specification describes an input device 14, which may be a keyboard, mouse, voice recognition unit, or any device capable of receiving instructions. The specification describes that through the input device 14 a user may make a selection on an online catalog. Specification, ll. 5-7, p. 5. The system of claim 56 also includes a processor to compile selections made through the user interface of the available products that are not currently offered in a line of available products or attributes. The compilation of selections are used as market research for a decision of whether to extend a product offering to include the list of products or attributes. In a particular embodiment of the invention, the specification describes a CPU 10 that compiles selections made via the input

device 14 for purposes of determining whether to extend a product offering to include a list of unavailable products or attributes. Specification, ll. 2-5, p. 5 and ll. 2-5, p. 7.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Can Claims 42, 44, 45, 53 and 54 Be Rendered Obvious under 35 U.S.C. § 103(a) as being Unpatentable Over House (U.S. Patent No. 6,785,805) in View of the EMCORE article When the Examiner Has Failed to Establish a *Prima Facie* Case of Obviousness?

B. Can Claims 56, 57, 58 and 59 Be Rendered Obvious under 35 U.S.C. § 103(a) as being Unpatentable Over House (U.S. Patent No. 6,785,805) in View of the EMCORE article When the Examiner Has Failed to Establish a *Prima Facie* Case of Obviousness?

ARGUMENT

A.   Can Claims 42, 44, 45, 53 and 54 Be Rendered Obvious under 35 U.S.C. § 103(a) as being Unpatentable Over House (U.S. Patent No. 6,785,805) in View of the EMCORE article When the Examiner Has Failed to Establish a *Prima Facie* Case of Obviousness?

The method of claim 42 recites providing an online catalog on a computer, with the catalog having an unavailable product/attribute selector to select an unavailable product or attribute that is not offered for sale. Claim 42 also recites using selections of available products or attributes that are not offered for sale obtained via the unavailable product/attribute selector as market research to determine whether to extend a product offering that includes the unavailable products or attributes.

Claim 42 stands rejected under 35 U.S.C. § 103(a) in view of House and the EMCORE article. In general, House describes a network that provides selectable configuration options for a test, measurement and automation (TMA) environment. House describes that some of these components are "off-the-shelf" components; and House describes that some of the components may be customized and built components, such as specific electronic circuits, printed circuit boards, custom software development, etc. *See, for example*, House, 4:59-67 and 5:1-3.

The EMCORE article recites EMCORE's expansion of its transceiver array program in response to customer requests for a transponder product. EMCORE does not elaborate regarding how the requests were obtained. EMCORE fails to teach or suggest obtaining customer requests for a new product via customer interaction with an online catalog and likewise fails to teach or suggest obtaining customer requests for a new product via selections that are made using a product selector of an online catalog.

A *prima facie* case of obviousness has not been established for claim 42 for at least the reason that the Examiner has not shown where the prior art teaches or suggests using a product selector in an online catalog for purposes of market research to determine whether to extend a product offering.

More specifically, the Examiner appears to rely on House for the general teaching of an online catalog and product selector and appears to rely on the EMCORE article for the teaching of expanding a product line based on customer requests. However, neither reference, alone or in

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combination, teaches or suggests expanding a product line based on selection of an unavailable product by a product/attribute selector of an online catalog. Without a teaching or suggestion of the missing elements, a *prima facie* case of obviousness has not been established for claim 42.

In the Final Office Action, the Examiner refers to *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) for the purported authority for relying on the general level of skill in the art to establish a *prima facie* case of obviousness. However, in *In re Fine*, the Federal Circuit held that the Examiner had *failed* to establish a *prima facie* case of obviousness for the reason that the Examiner failed to show where the prior art taught or suggested all claim limitations. Rarely, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. *Al-Site Corp. v. VSI Int'l, Inc.,* 50 USPQ2d 1161, 1171 (Fed. Cir. 1999). Thus, the Examiner must show why one skilled in the art, *without knowledge of the claimed invention*, would have derived the claimed invention in view of the EMCORE reference and House. Objective evidence is required, as mere speculation by the Examiner is not sufficient to establish a *prima facie* case of obviousness. *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Therefore, for at least the foregoing reasons, the § 103 rejections of claims 42-55 are in error and should be reversed.

B.   Can Claims 56, 57, 58 and 59 Be Rendered Obvious under 35 U.S.C. § 103(a) as being Unpatentable Over House (U.S. Patent No. 6,785,805) in View of the EMCORE article When the Examiner Has Failed to Establish a *Prima Facie* Case of Obviousness?

Independent claim 56 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of the EMCORE article.
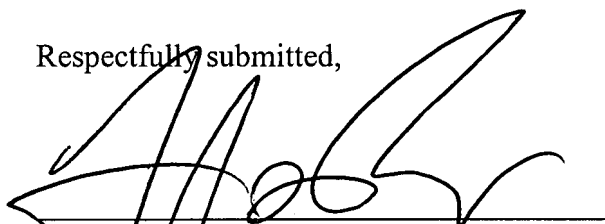
The system of claim 56 includes a user interface that is in communication with a processor and is adapted to display a list of products or attributes that are not currently offered in a line of available products or attributes from a provider. The system includes a processor to compile selections made through the user interface of the available products that are not currently offered in a line of available products or attributes. The compilation of selections are used as market research for a decision of whether to extend a product offering to include the list of products or attributes.

A *prima facie* case of obviousness has not been established for claim 56 for at least the reason that neither House nor EMCORE teaches or suggests a processor to compile the selections, as recited in claim 56. In this regard, House's system does not compile selections of products that are not currently offered in a line of available products or attributes for purposes of market research. The EMCORE article merely sets forth expanding a product line based on customer requests. However, neither House nor EMCORE teaches or suggests the processor that is set forth in claim 56, as neither reference teaches or suggests a processor that compiles selections of unavailable products made in an online catalog for purposes of market research regarding whether to extend a product offering. Without a teaching or suggestion of the missing claim limitations, a *prima facie* case of obviousness has not been set forth for claim 56.

Thus, for at least the foregoing reasons, the § 103 rejections of claims 56-62 are in error and should be reversed.

Applicant respectfully requests that each of the final rejections be reversed and that the claims subject to this Appeal be allowed to issue.

Respectfully submitted,

Date: June 5, 2007

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CLAIMS APPENDIX

The claims on appeal are:

42. A method comprising:

providing an online catalog on a computer, the catalog having an unavailable product/attribute selector to select an unavailable product or attribute that is not offered for sale; and

using selections of unavailable products or attributes that are not offered for sale obtained via the unavailable product/attribute selector as market research to determine whether to extend a product offering that includes the unavailable products or attributes.

43. The method of claim 42, further comprising:

suggesting an existing/standard product based upon and as a replacement for the selection.

44. The method of claim 42, further comprising:

determining a resource cost for the unavailable product/attribute.

45. The method of claim 42, further comprising:

assigning a category of design requirements to the unavailable product/attribute.

46. The method of claim 45, further comprising:

determining a resource cost for the unavailable product/attribute;

assigning a first category to the unavailable product/attribute if the resource cost is relatively lower;

assigning a second category to the unavailable product/attribute if the resource cost is relatively higher.

47. The method of claim 45, further comprising:

transmitting a request for the unavailable product/attribute to an address associated with the assigned category.

48. The method of claim 47, further comprising:

transmitting the request to a manufacturing facility for the unavailable product/attribute if it is assigned to a first predefined category.

49. The method of claim 47, further comprising:

transmitting the request to an engineering department for the unavailable product/attribute if it is assigned to a second predefined category.

50. The method of claim 42, further comprising:

providing a list of available products in the online catalog.

51. The method of claim 50, further comprising:

obsoleting an available product by moving it from the list of available products to a list of unavailable products.

52. The method of claim 42, further comprising:

receiving an order of an available product and transmitting a request to a manufacturing facility.

53. The method of claim 42, wherein the unavailable product/attribute selector comprises a list of unavailable products/attributes.

54. The method of claim 53, further comprising:

classifying an item in the list of unavailable products/attributes.

55. The method of claim 42, wherein the unavailable product/attribute selector comprises an online form.

56.   A system comprising:

a user interface selection device in communication with the processor, the user interface selection device adapted to display a list of products or attributes that are not currently offered in a line of available products or attributes from a provider; and

a processor to compile selections made through the user interface of the available products that are not currently offered in a line of available products or attributes, the compilation of selections to be used as market research for a decision of whether to extend a product offering to include the list of products or attributes.

57.   The system of claim 56, wherein the processor stores in a memory of the system a list of unavailable products/attributes.

58.   The system of claim 57, wherein the processor displays the list of unavailable products/attributes on a visual interface of the system.

59.   The system of claim 57, wherein the processor stores in a memory of the system a category of design requirements associated with the unavailable products/attributes.

60.   The system of claim 56, wherein the processor is adapted to receive a selection of an unavailable product/attribute via a selection signal from a user interface selection device of the system; and

display a resource cost of the unavailable product/attribute on a visual interface of the system.

61.   The system of claim 56, wherein the processor is adapted to receive a selection of an unavailable product/attribute via a selection signal from a user interface selection device of the system; and

identify, by a CPU of the system, one or more available products, from the list of available products, that has similar characteristics to those of the selected unavailable product/attribute; and

display the identified one or more available products on a visual interface of the system.

62.   The system of claim 56, wherein the processor is adapted to generate a specification for a product in response to receiving, by a CPU of the system, a selection signal from the user interface selection device of an unavailable product/attribute.
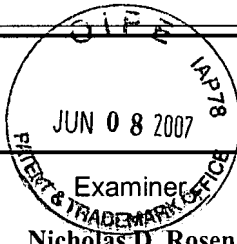
EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.

TRANSMITTAL OF APPEAL BRIEF (Large Entity)	Docket No. 22.1489

In Re Application Of: **Jean-Luc Pous et al.**

JUN 0 8 2007

Application No. 10/043,856	Filing Date 01/11/2002	Examiner Nicholas D. Rosen	Customer No. 21906	Group Art Unit 3625	Confirmation No. 8450

Invention: **CUSTOM ENGINEERED PRODUCT SYSTEM AND PROCESS**

COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

April 2, 2007

The fee for filing this Appeal Brief is: **$500.00**

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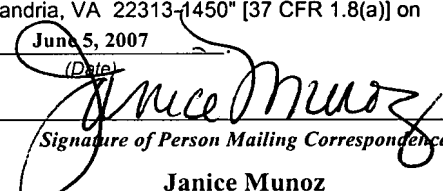
Signature

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Dated: **June 5, 2007**

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P30LARGE/REV08